

REMARKS

No claims are added, cancelled, or amended. Hence, Claims 1-26 are pending in the application.

I. SUMMARY OF THE REJECTIONS

Claims 1-9, 11-22, and 24-26 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,738,770 issued to Gorman ("*Gorman*"). This rejection is respectfully traversed.

Claims 10 and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Gorman* in view of U.S. Patent Publication No. 2003/0110227 to O'Hagan ("*O'Hagan*"). This rejection is respectfully traversed.

II. DECLARATION UNDER 37 CFR § 1.131

The attached declaration and accompanying exhibit proves that an implementation of Claims 1 – 26 was developed and successfully tested before the provisional filing date of *Gorman*, which is November 4, 2000. Therefore, Claims 1 – 26 were reduced to practice by the inventor before the provisional filing date of *Gorman*. *Gorman* cannot be used as a valid basis for rejecting Claims 1 – 26 under 102(e) or 103(a). Reconsideration and allowance of Claims 1 – 26 is respectfully requested.

A. Applicant is Not Required to Show Diligence

In the “Response to Arguments” section (page 9), the Final Office Action alleges that the previous declaration is ineffective to overcome *Gorman*. Specifically, the Final Office Action stated that the “evidence submitted is insufficient to establish **diligence** from a date prior to the date of reduction to practice of the [*Gorman*] reference to either a constructive

reduction to practice or an actual reduction to practice” (emphasis added). However, Applicant is not attempting to prove diligence.

37 C.F.R. § 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter, one of which is an actual reduction to practice of the invention prior to the effective date of the reference (see also MPEP § 715.07(III)). No diligence is required in that case.

B. Evidence is Sufficient to Establish a Reduction to Practice

The Final Office Action also asserts that the evidence submitted is insufficient to establish a reduction to practice of the invention (page 9). Specifically, the Final Office Action alleges that “there are no factual assertions sufficient to show the claimed subject matter. Applicant’s lack any exhibits, which state any of the claim limitations.” It is respectfully submitted that this is incorrect.

1. Exhibits are not required by the C.F.R. or the MPEP

37 C.F.R. § 1.131(b) does not require evidence to be submitted in the form of exhibits. Rather, that section states:

The showing of facts shall be such, **in character and weight, as to establish reduction to practice prior to the effective date of the reference**, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration **or their absence must be satisfactorily explained**. (emphasis added)

Thus, exhibits are not required. Instead, what is required is a showing of facts that, in character and weight, establishes reduction to practice prior to the effective date of the reference. MPEP § 715.07(I) is consistent with 37 C.F.R. § 1.131(b) when MPEP § 715.07(I) states: “Evidence in the form of exhibits **may** accompany the affidavit or declaration” (emphasis added).

Additionally, MPEP § 715.07(I) further states that claimed limitations may be supported by the declaration itself rather than by an exhibit (see also *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989)).

The MPEP warns against providing general allegations in declarations. However, the attached declaration (as well as the previous declaration) is very specific. The inventor composed software that, when executed, implemented Claims 1 – 26 before November 4, 2000 (declaration, ¶ 3). Successful tests were run, before November 4, 2000 and in this country, to show that the software worked according to Claims 1 – 26 (declaration, ¶ 4). The software, when executed by a computer, causes the computer to perform the specific steps of Claim 1 and Claim 11 and each of the remaining dependent method claims (declaration, ¶ 5-7). The declaration itself is direct evidence of a reduction to practice of the claimed invention.

Furthermore, the courts have stated that “the PTO is required to accept Rule 131 Affidavits at face value, and without investigation” (see, e.g., *Herman v. Williams Brooks Shoe Co.*, 39 USPQ2d 1773, 1777 (S.D. N.Y. 1996); see also Chisum on Patents § 3.08[1][a] (2005); emphasis added). Based on the specific evidence provided in the declaration, the Applicant has satisfied his burden to prove that a working implementation of the invention according to Claims 1-26 existed prior to November 4, 2000.

2. *Exhibit A*

Despite the absence of the requirement to file an exhibit with a Rule 131 declaration, Exhibit A is filed as additional proof that the invention according to Claims 1 – 26 was reduced to practice before the provisional filing date of *Gorman*.

In addition to the successful tests (i.e., of the subject software) that were conducted before the provisional filing date of *Gorman* (declaration, ¶ 3), usability tests that ran the

software were also performed and completed before the provisional filing date of *Gorman* (declaration, ¶ 9). Exhibit A describes the methods used and results obtained from the usability tests (declaration, ¶ 10).

Exhibit A explicitly references a prototype, which comprises the subject software that, when executed, implemented Claims 1 – 26 (declaration, ¶ 11). It is a standard practice at Oracle to test the functionality and usability of software before the software is included in a product for a customer (declaration, ¶ 11). This process tends to ensure that any significant “bugs” are identified and subsequently removed before the software is shipped to the customer.

Page 8 of Exhibit A references an aspect of the prototype, which corresponds to the invention according to Claims 1 – 26 (declaration, ¶ 12). Page 8 states, among other things: “**For the list of books:**...Allowed users to select a category from a dropdown list, after which icons appear to indicate which books are in that category” (emphasis in original). This portion of Exhibit A corresponds to elements b), c), and d) of Claims 1 and 11 according to ¶ 5 and ¶ 6 of the declaration.

3. *The declaration is evidence of a reduction to practice of the invention*

It is important to note that “the examiner **must consider all of the evidence** presented in its entirety, **including the...declarations**” (MPEP § 715.07(I); emphasis added). Thus, the declaration itself *is* evidence (that the invention was reduced to practice before the provisional filing date of *Gorman*), which evidence must be considered by an examiner. The examiner must also take the statements in the declaration at face value and without investigation (see *supra Herman*, 39 USPQ2d 1773, 1777).

The Final Office Action alleges that “Applicant’s lack any exhibits, which state any of the claim limitations.” However, as stated above, neither the C.F.R. nor the MPEP require

exhibits. They are optional. Furthermore, neither the C.F.R. nor the MPEP require exhibits to state claim limitations. Instead, MPEP § 715.07(I) states that an “exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself” (emphasis added). Each of the claim limitations are supported by the declaration (see declaration, ¶ 5 – 8).

Based on the foregoing, it is respectfully submitted that the declaration and Exhibit A are sufficient to establish a reduction to practice of the invention (i.e., according to Claims 1 – 26) prior to the provisional filing date of *Gorman*.

III. CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,
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